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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,389	05/26/2006	Abdulsalam Al-Mayahi	663073607	3744
25269 7590 01/11/2008 DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005			EXAMINER FORTUNA, ANA M	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 01/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,389

Applicant(s)

AL-MAYAH ET AL.

Examiner

Ana M. Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/3/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/18166 (hereinafter WO '166) in view of Lefebvre (US 4,781,837) and Mickols (US 5,755,964). Publication WO'166 discloses a process for removing solvent, e.g. water, from saline water, such a brackish water, gray water, sea water etc. The process include the steps of disposing the solution to be treated at one side of a semi-permeable hydrophilic membrane, and disposing a second solution having a higher osmotic potential, e.g. salt brine (abstract, Figs. 1 and 6; page 3, line 11-page 4, line 30). Solvent (water) passes across the membrane, diluting the second solution during the process; the second solution is further concentrated by removing water by reverse osmosis, electrodialysis, evaporation, or combination (abstract, step b). The membrane can be a thin film composite hydrophilic membrane in

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different configurations (page. 11, third paragraph). The use of nanofiltration in the concentration step (b) is not disclosed in this reference (WO'166).

Patent '837 teaches combining osmotic separation using a concentrate salt solution and a hydrophobic membrane and concentration the diluted concentrate solution by a reverse osmosis membrane and recirculating the concentrate salt solution back to the process (abstract, column 2, lines 38-column 3, line 20; column 4-column 5, line 26).

Patent does not teach "nanofiltration, however, teaches the bases for membrane selection and membrane salt combination; the reference suggests the use of more open membranes to concentrate the osmotic(concentrate solution) that has been dilute and recycle back to the process; the membrane can have a larger pore size but has to be capable or retaining the large anion, or charged membrane capable of retaining hydrogen ions and anions of any size (column 11, lines 15-27). Based on this teachings, it would have been obvious to one skilled in this art at the time this invention was made to substitute the reverse osmosis membrane in the process of WO'166, by a nanofiltration membrane , which is known to retain divalent salts from the high osmotic potential solution, or brine salt. It would have been obvious to one skilled in this art at the time the invention was made to predict the retention or magnesium sulfate or sodium sulfate, as in claim 7 of the present invention, by using a nanofiltration, base on the membrane retention of divalent ions.

Patent '964 is further cumulative, ad teaches use of nanofiltration membrane and its retention of divalent ions and organic compounds, such as glucose retention (column 1, lines 32-37, and column 3, lines 41-53). Further advantages of using nanofiltration, such

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a high flux and lower pressure requirements are disclosed in this patent (column 2, second paragraph). It would have been further obvious to one skilled in this art at the time this invention was made to use nanofiltration membranes to concentrate the concentrate solution or high osmotic potential solution to reduce the pressure requirements during the concentration and increase flux, and more particularly to retaining any divalent ions present in the second solution, to produce water with an adjusted monovalent content as product from the nanofiltration stage.

As to claims 2, and 17-19 the nanofiltration pore size is lower than the ultrafiltration range, therefore, the membrane will retain any particle having a size greater than 0.001, which is the lower range of ultrafiltration pore. As to claim 3, adjusting the amount of salt in the second solution to keep the higher osmotic potential, e.g. to allow the driving force to direct the solvent across the membrane to the second solution is required in order to perform the solvent separation during the process.

Regarding claims 4-6, publication WO'166 teaches combining membrane concentration with evaporation (abstract, page 2, lines 27-34, and page 4, lines 15-30). The specific evaporation methods are not disclosed in WO'166, but are covered by the term "thermal evaporation (page 2, line 30). It would have been obvious to one skilled in the art at the time this invention was made to select any of the conventional methods of thermal evaporation for concentrating to reach to higher concentrations of the osmotic solution, based on the suggestion of combining both, the membrane step and evaporation.

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Claim 7 is discussed above. For claims 8-14, 19, the solvent in the first solution is water, as discussed above, and the solvent in the second solution is a "brine solution", containing divalent salts (page 3, lines 13-34).

4. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/18166 (hereinafter WO '166) in view of Lefebvre (US 4,781,837) and Mickols (US 5,755,964) as applied to claims 1 above, and further in view of Herron et al (US 5,281,430). WO'166, '837, and '964 discussed above fail to disclose the antifouling agent or disinfectant in the second solution. Patent '430 teaches cleaning the membrane in an osmotic membrane separation process, by using antiscalant or antifoaming agent, to remove residues from the membrane in the side where the osmotic agent is provided; Ultrasil (column 14, example 4). The patent does not provide the agent in the osmotic solution. The skilled person in this art at the time this invention was made at the time this invention was made was able to predict the improvement in membrane cleaning by providing the agent (antifouling agent) within the concentrate solution, e.g. cleaning the membrane in operation.

5. Claims 1, 2, 3, 7, 8, 9, 15, 16, 17, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaeli (US 5,098,575) in view of Mickols (US 5,755,964) and further in view of Lefebvre (US 4,782,837). Yaeli discloses a process of purifying seawater by combining natural osmosis and reverse osmosis, e.g. the step of concentration of the second solution is performed in a reverse osmosis membrane, which has inherent pore size within the lower pore size range claimed in claims 2, and 17 (see abstract, figure, and column 3, lines 15 through column 4, line 44). Using a

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nanofiltration membrane in step b), to concentrate the dilute solution is not disclosed in the patent. Patent '964 discloses the properties of nanofiltration membranes and its divalent ion rejection, low pressure operation and high membrane flux as compared to the reverse osmosis membrane, as discussed in the paragraphs above. Patent '837, also discussed above teaches combining osmotic distillation and reverse osmosis and suggests using membranes of higher pore size to concentrate the osmotic solution containing magnesium sulfate, as discussed in the paragraphs above. It would have been obvious to one skilled in this art at the time this invention was made to substitute the reverse osmosis membrane in Yaeli by a nanofiltration membrane, e.g to increase the flux, reduce operational costs by reducing the pressure applied to the membrane separation, and retain the osmotic agent in the osmotic solution, since nanofiltration membranes retain sugar molecules, in addition to divalent ions, as disclosed in '964. As to claim 2, the retention of particles or components with sizes as claimed are inherent of the membrane, based on the nanofiltration membrane molecular weight cut-off. As to claims 4-6, concentrating the diluted second solution by evaporation is disclosed in patent '430, therefore, further combining reverse osmosis and evaporation to further concentrate the osmotic agent solution would have been obvious to the skilled artisan.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Additional cited references teach solvent separation by an

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osmotic agent or solution at an opposite side of the feed solution, e.g natural osmosis, and its use for producing potable water and hydrating or dehydrating fluids or solutes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M. Fortuna whose telephone number is (571) 272-1141. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ana Fortuna/
Primary Examiner, A. U. 1723

AF
October 25, 2007